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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,478	12/30/2004	Avigdor Bieber	P-5022-US	2656
27130	7590	02/24/2006	EXAMINER	
EITAN, PEARL, LATZER & COHEN ZEDEK LLP 10 ROCKEFELLER PLAZA, SUITE 1001 NEW YORK, NY 10020			JOHNSON, CONNIE P	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/519,478

Applicant(s)

BIEBER ET AL.

Examiner

Connie P. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/30/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to a lithographic printing member, classified in class 430, subclass 270.1.
- II. Claims 13-19, drawn to an on-demand plate making apparatus, classified in class 101, subclass 465.
- III. Claims 20-23, drawn to a method of guiding a form film and a substrate, classified in class 101, subclass 005.

Inventions I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product can be made by a materially different apparatus such as: an apparatus further comprising a dispensing unit to prepare the laser-absorbing layer.

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by a materially

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different process such as a method of on-press exposing and processing the printing plate using a substrate, an ink/fountain solution developable photosensitive layer and a protective layer.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are unrelated because invention II is drawn to an apparatus and invention III is drawn to a method for guiding a form film and substrate and does not include an apparatus.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Naomi Liver on 01/19/2006 a provisional election was made with traverse to prosecute claims 1-12. Affirmation of this election must be made by applicant in replying to this Office Action. Claims 13-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Teng, U.S. Patent No. 6,245,486 B1.

Teng teaches a printing plate comprising a substrate (base layer), a photosensitive layer and a mask layer (laser-absorbing layer) (abstract). Teng also teaches 2 additional layers, an interlayer, which can be interposed between the mask layer and the photosensitive layer (column 6, lines 36-39) and a thin transparent top layer (coating layer) that can be deposited on top of the mask layer (column 4, lines 55-57). The thin transparent layer is on top of the mask layer and may contain water-soluble polymers (column 4, lines 60-61). Since the thin transparent layer is hydrophilic, it meets the limitations of instant claim 8. The thin transparent layer is over the laser-absorbing layer and therefore meets the limitations of the primer layer in instant claim 12. Teng teaches that the substrate may have an oleophilic or oleophobic surface. Therefore, the printing plate may contain a hydrophilic coating layer and an oleophilic base which meets the limitations of the layers having different affinities for ink. The mask layer contains metals and metal oxides, such as aluminum and aluminum oxide as in instant claim 2 (column 5, lines 37-43). The thickness of the mask layer varies from 30 to 200 angstroms or 0.003 to 0.02 micron as in instant claim 6 (column 5, lines (58-60). The metal/metal oxides used in the mask layer are deposited by vapor deposition, which requires the metals to be in vapor form and condensed to form a solid material. Since the vapor materials are condensed to form a solid dispersion throughout the mask layer, the concentration of the metal/metal oxides and would vary throughout the layer (column 5, lines 62-65). According to page 8, lines 16-26 of the specification, the base layer would have a higher affinity to the metal/metal oxide ratio than the coating layer, since the bottom of the mask layer (closest to the base layer) has a higher

concentration of metal than the top of the mask layer. Teng also teaches that the thin transparent top layer is capable of being ablated off when coated on a laser ablative mask layer (column 4, lines 55-60). The ablation is performed by laser exposure to actinic light in the ultraviolet and visible region. The uv curable materials used in the mask layer are also representative of those used in the coating layer for ablation and therefore meets the limitations of instant claim 9 (column 5, lines 1-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeyama et al., U.S. Patent No. 5,691,103.

Takeyama et al. teaches a multilayer image forming material comprising a support and an image-forming layer (abstract). Takeyama et al. does not teach a metal/metal oxide ratio in the image-forming layer. The image-forming material may be heated using a hot stamp or heat roller (column 11, lines 12-15) and is therefore representative of a printing member. The image-forming layer does contain a metal compound and a light-to-heat converting compound. The thickness of the image-forming layer is 0.05 to 5.0 μ m (column 7, line 38). Although the reference does not teach a metal/metal oxide ratio in the image-forming layer, the metal compound may

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combine with a metal oxide powder as a light-heat converting compound in the image-forming layer (column 4, lines 13-20). The image-forming material may also contain an adhesive layer (column 9, lines 64-67) and a peeling layer (column 9, lines 23-26). The adhesive layer is representative of a coating layer. The peeling layer is representative of a form film, which upon exposure to actinic radiation may be removed. A polyolefin resin, such as polypropylene is used in the peeling layer (column 8, lines 46-58) and (column 9, line 35). Takeyama et al. does not teach that the polymeric film has a low surface density. It would have been obvious to one of ordinary skill in the art to use a low surface density polymer film in order to complete the image-forming process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Connie P. Johnson whose telephone number is 571-272-7758. The examiner can normally be reached on 7:30am-4:00pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CYNTHIA H. KELLY
SENIOR PATENT EXAMINER
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